

Appl. No. 09/903,266
Atty. Docket No. AA473
Amtd. dated March 15, 2004
Reply to Office Action of 12/15/2003
Customer No. 27752

REMARKS

Claims 1-15 and 17-23 are pending in the present application. No additional claims fee is believed to be due.

Claim 16 is canceled without prejudice. The Office Action's objection to Claim 16 is therefore obviated.

Rejection Under 35 USC 112, Second Paragraph

The Office Action rejects Claim 14 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the statement "... each of the recommended fabric care products have at least one common characteristic ..." makes the claim indefinite since commonality requires a comparison but the claim does not cite what comparison is intended. Applicants respectfully disagree and submit that the rest of the claim specifies what comparison is intended by defining the common characteristic as one "selected from the group consisting of perfume, product color, package color, and mixtures thereof." Therefore one skilled in the art will readily appreciate that the comparison is based upon perfume, product color, package color, and mixtures thereof. As such, the rejection under 35 USC 112 is respectfully requested to be withdrawn.

Rejection Under 35 USC 102(e) Over Koopersmith

The Office Action rejects the claims under 35 USC 102(e) in view of Koopersmith (US 2001/0042002 A1). Applicants submit that Koopersmith fails to identically show all the elements of the presently claimed invention. "For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference." ... These elements must be arranged as in the claim under review, ... but this is not an 'ipissimis verbis' test." *In re Bond*, 910 F.2d 831, 15, USPQ2d 1566, 1567 (Fed. Cir. 1990). Applicants assert that Koopersmith fails to show the presently claimed method for recommending fabric care products with specific mention to the following claim elements:

"collecting personalized consumer data pertaining to a consumer's *fabric care needs*;"
and

"determining a recommendation for one or more *fabric care products*."

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Applicants submit that no mention is made in Koopersmith regarding fabric care – either collecting data regarding a consumer's fabric care needs or recommending a fabric care product. The Office Action, at best, cites to paragraphs 0126 to 1327, which represents a citation to over 1200 paragraphs as authority for showing the claim element of collecting data regarding a consumer's fabric care needs. Applicants fail to see any paragraph that identically shows “collecting personalized consumer data pertaining to a consumer's *fabric care needs*.” In any event, Applicants submit that such a vague reference to over 1200 paragraphs fails to meet the Office's duty to establish a *prima facie* case of anticipation.

The Office Action cites to paragraph 004 for identically showing the claim element of “determining a recommendation for one or more *fabric care products*.” Applicants' review of paragraph 004 reveals a method of purchasing a “two slice toaster oven.” No mention is made of fabric care products. The Office Action also cites to Fig. 1 and paragraph 92. Again, Applicants submit that Fig. 1 and paragraph 92 is directed to a “two slice toaster” and not a fabric care product.

Given that the Office Action fails to establish that Koopersmith shows each and every element of the claimed invention identically, the pending claims are novel over Koopersmith and thus the rejection under 35 USC 102 is respectfully requested to be withdrawn.

Piece Meal Prosecution To Be Avoided

According to MPEP section 707.07 (g) piecemeal examination is to be avoided as much as possible. The Office Action concludes by citing to a few references as being not relied upon but considered “pertinent” to Applicant's disclosure. Applicants assert that the claimed invention is patentable over these references and remind the Office of the MPEP's prohibition of piece meal prosecution.

CONCLUSION

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 USC 112 and 102. Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing,

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Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1-15 and 17-23.

Respectfully submitted,

By David V. Upite

David V. Upite
Attorney for Applicant(s)
Registration No. 47,147
(513) 627-8150

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